

instant restriction requirement has not been made within the allotted time period as specified in 37 C.F.R. § 1.142(a), and for this reason alone the requirement for restriction should be withdrawn. Should the Examiner make final this requirement for electing a group of claims from a set of claims that has already been considered, searched, examined, and allowed, Applicants respectfully request that the Examiner identify the authority for doing so.

Furthermore, restriction remains improper unless it can be shown that the search and examination of all groups would entail a "serious burden." *See* M.P.E.P. § 803. In the present situation, no such showing has been made. Indeed, examination of all four identified groups would entail no burden whatsoever, since examination of all pending claims was completed three years ago. For this reason alone, the requirement for restriction should be withdrawn.

To comply with the pending election requirement, Applicants herein provisionally elect, *with traverse*, the claims currently restricted to Group IV (*i.e.*, claims 234-235 and 237-264) directed to isolated polypeptides and methods for using them. Moreover, since the claims of Groups IV (polypeptides) and I (methods of attenuating an infection comprising administering the polypeptides of Group IV) are related as between a product and a process for using the product, and the process claims include all the limitations of the product, the Examiner in any case would be obligated to rejoin the method claims if the elected product claims are found allowable (as, indeed, they already have been). In light of the decisions in *In re Ochiai*, 71 F.3d 1565, 37 USPQ2d 1127 (Fed. Cir. 1995) and *In re Brouwer*, 77 F.3d 422, 37 USPQ 2d 1663 (Fed. Cir. 1996), a notice was published in the Official Gazette which set forth new guidelines for the treatment of product and process claims. *See* 1184 OG 86 (March 26, 1996). Specifically, the notice states that "in the case of an elected product claim, rejoinder will be permitted when a product claim is found allowable and the withdrawn process claim depends from or otherwise includes all the limitations of an allowed product claim." *Id.* Accordingly, Applicants respectfully request that since the claims of Group IV are allowable, the process claims of Group I be rejoined.

Applicants retain the right to petition from the restriction requirement under 37 C.F.R. § 1.144.

### ***Conclusion***

Applicants respectfully request that the above-made remarks be entered and made of record in the file history of the instant application. The Examiner is invited to call the

undersigned at the phone number provided below if any further action by Applicant would expedite the examination of this application.

If there are any fees due in connection with the filing of this paper, please charge the fees to our Deposit Account No. 08-3425. If a fee is required for an extension of time under 37 C.F.R. § 1.136, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

Dated: 7 April 2003

  
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